

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Patent Of: Marc Van Heyningen et al.

U.S. Pat. App. No.: 09/783,146

Filed: February 13, 2001

For: Method And Apparatus For Providing
Secure Streaming Data Transmission
Facilities Using Unreliable Protocols

Examiner: Kambiz Zand

Group Art Unit: 2132

PETITION FOR WITHDRAWAL OF COMMUNICATION DISMISSING APPEAL

Commissioner for Patents
P.O. Box 1450,
Alexandria, Virginia 22313-1450

Sir:

Applicants respectfully request that the Communication dated December 15, 2006, dismissing the appeal in this application, be withdrawn. The basis of the Communication is wholly inaccurate. Moreover, the Supervisory Primary Examiner who issued the Communication clearly had no authority to dismiss Applicant's appeal without first giving Applicant the opportunity to correct the alleged shortcomings in Applicants' Appeal Brief.

In the Communication, Supervisory Primary Examiner (SPE) Kambiz Zand indicated that the appeal in the instant application was being dismissed because:

The applicant's arguments do not contain clearly the claims at issue. As an example the applicant's appeal brief arguments only addresses [sic] independent method claims 1 and 47 and it's [sic] limitation (see page 8, line 3 of the appeal brief) and it is silent with respect to independent claims 38, a system claim and also claim 20, a method claim. As best understood [sic] from pages 8-14 only claims 1, 7, 9-12, 24, 27, 40, 43, 49 and 53 have been addressed regarding the 102 and 103 rejection rendered by Examiner [sic]. The appeal brief is dismissed since

the brief do [sic] not contain a clear arguments [sic] with respect to the claims at issue in a clear manner addressing each claim or a group of claims with similar limitation [sic] specially [sic] with respect to independent claims (i.e. claim 38 a system claims is not addressed, does it means [sic] the rejection acceptable to application?). Examiner suggets [sic] inclusion of a heading for each claim or groups of claims with similar limitation. (See Communication, page 2, lines 9.)

Applicant first points out that SPE Zand had no authority to dismiss the appeal. MPEP

§1205.03 plainly states:

The question of whether a brief complies with the rule is a matter within the jurisdiction of the examiner ~~**>~~and the Board. The examiner will review the brief to ensure that the required items of the brief are present. Both the Board and the examiner will review the brief for compliance with the content requirements of the brief (37 CFR 41.37(c)). 37 CFR 41.37(d)< provides that if a brief is filed which does not comply with all the requirements of paragraph (c), the appellant will be notified of the reasons for noncompliance. Appellant will be given ~~** 1 month or 30 days from the mailing of the notification of non-compliance, whichever is longer ~~**>~~~~ to file an amended brief.~~<~~ Extensions of time may be granted under 37 CFR 1.136(a) or 1.136(b). The ~~*>~~Office~~<~~ may use the form paragraphs set forth below or form PTOL-462, "Notification of ~~**>~~Non-Compliant Appeal Brief (37 CFR 41.37)~~<~~" to notify appellant that the appeal brief is defective. *The appeal will be dismissed if the appellant does not timely file an amended brief, or files an amended brief which does not overcome all the reasons for noncompliance of which the appellant was notified.* (MPEP §1205.03, *emphasis added.*)

Because SPE Zand did not first provide Applicants with an opportunity to correct the alleged "reasons for noncompliance," his dismissal of the appeal was premature and improper. In view of this straightforward directive in the MPEP, Applicants respectfully submit that the SPE's dismissal of the appeal in this application was in error.

Moreover, the assertions made by SPE Zand in the Communication are obviously in error as well. SPE Zand stated that Applicants' brief was "silent" with respect to claims 38 and 20. Applicants respectfully invite Examiner's Zand's attention to the portion of Applicants' Brief at page 7, line 22 to page 8, line 3, which (i) states that the rejection of claims 20 and 38 (among

others) was improper, and (ii) requests that the rejection of these claims be withdrawn.

In the subsequent paragraph, Applicants' Brief points out that each of the method claims (which include claim 20) relate to:

...a process of (1) transmitting encrypted data records between two computers during a communication session, and (2) providing session information for decrypting the records to another computer (i.e., a computer outside of that communication session). (See Applicants' Brief, page 8, lines 3-6).

Applicants' Brief then explains in detail why these features of the invention are not taught or suggested in U.S. Patent No. 6,216,229 to Fischer.

Applicant's Brief further argues that each of the apparatus claims (which include claim 38) similarly recite:

(1) a first computer that uses an encryption key to encrypt and send data records to a second computer, which decrypts the data records using the decryption key, and (2) a third computer storing the encryption key. (*Id.*, lines 6-9.)

It then discusses why these features of the invention likewise are not taught or suggested in U.S. Patent No. 6,216,229 to Fischer. Lastly, Applicants' Brief specifically requests that, based upon the discussed differences between the recited features of the invention and the teachings in the Fischer patent, the rejections of claims 20 and 38 (among others) be withdrawn. (*Id.*, page 11, lines 4-7.) It is unclear how, after even a cursory reading of Applicants' Appeal Brief, the SPE can question "does it means [sic] the rejection [of claims 20 and 38] acceptable [sic] to applicant?"

In summary, Applicants respectfully point out that the Communication issued by SPE Zand dismissing Applicant's appeal was in direct contravention of the examination procedures set forth in the MPEP. Further, the factual basis upon which the Communication was predicated

is wholly inaccurate. Applicants therefore ask that the Communication be withdrawn, and that the appeal of the Supervisory Primary Examiner's final rejections be officially reinstated.

In the event that this Petition is not granted, Applicants have attached hereto a Supplemental Appeal Brief that includes the additional headings suggested by SPE Zand. Applicants respectfully submit that no fees are due for the consideration and entry of this Supplemental Appeal Brief should they be necessary. As discussed in detail above, the underlying requirement for this Supplemental Appeal Brief was improper. If, however, the Commissioner deems that one or more fees are required for the consideration and entry of this Supplemental Appeal Brief, Applicants request that the Commissioner charge such fees to the deposit account of the undersigned, Deposit Account No. 19-0733.

Favorable action with regard to this Petition is courteously requested at the Examiner's earliest convenience.

Respectfully submitted,

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